

BEST AVAILABLE COPY**PATENT****REMARKS**

This reply is in response to the Office Action dated October 7, 2006. Claims 1-76 are pending in the application and stand rejected. Claim 43 has been amended to correct an unintentional transcription error. As such, that proposed amendment is not intended to narrow the claim or otherwise limit the scope of equivalents thereof. Entry of the foregoing amendment and reconsideration of the claims is respectfully requested.

Claims 1-76 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Albazz et al. (US 2002/0042782). The Examiner states that the reference discloses:

A system and method for automating the contracting negotiation and preparation cycle and for electronically facilitating subsequent contractual activities executed pursuant to the contract. The system for generating a contract comprises a Business Rules Book containing a set of rules from which specific rules may be selected for inclusion in the contract. A Terms and Conditions Set representing a unique set of instances of rules selected from the Business Rules Book is selected from a plurality of stored Terms and Conditions Sets. The seller and buyer settle the provisions of the contract by agreeing to mutually acceptable set of Terms and Conditions. The administering organization creates a Product List Filter specific to each seller or buyer, targeting products in which there is mutual interest. The Business Rules Book, Terms and Conditions and Product List Filter are linked in a contract profile, to create a contract representing the agreement between the seller and the buyer, and the contract is locked. Subsequent contractual activities under the contract are executed through the contract, which automatically inserts values from the terms and conditions of the contract to ensure conformity with the terms of the contract and minimize manual administrative activities (e.g. abstract).

The Examiner concludes that it would have been obvious to modify Albazz to include a single contract database because databases are old and well-known in the field, and such a modification would be motivated by the need for greater efficiency in the storage of necessary data for the generation of contracts.

Applicant respectfully disagrees on grounds that Albazz does not teach, show, or suggest the claimed invention. Albazz discloses "a system and method for automating the contract negotiation and preparation process." See, e.g. Albazz at paragraph [0043]. According to Albazz, at least four databases (e.g. Business Rules Book (BRB), Terms and Conditions

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Instances, Product List Filters, and Linking Contract Elements) are required to generate a contract. *Id.* at paragraph [0051]. "Each Terms and Conditions set created from the Business Rules Book and Terms and Conditions Instances is an entity independent of a contract." *Id.* at paragraph [0071]. The system of Albazz is intended to eliminate unilateral manipulation or changes to an agreed contract, but yet allow the preparation of new contracts based on the buyer's and seller's previously agreed terms and conditions.

Furthermore, Albazz teaches that once the contract is finalized and "locked," the "active contracts are exposed to other e-commerce subsystems" (i.e. other additional databases). *Id.* at paragraph [0098]. As such, Albazz does not teach, show, or suggest a single contract database, as recited in every claim. Likewise, Albazz also does not teach, show, or suggest a single contract database comprising data obtained from multiple contract documents, said data organized into fields comprising: draft contract status, contract identifier, contract type, effective date, and expiration date; and a field comprising obligation type, owner, status or due date; said system capable of generating reports based on said database, said reports obtainable through search of said fields; and said database being selectively accessible by a plurality of users, as recited in claim 1 and those dependent therefrom. For at least these reasons, withdrawal of the rejection and allowance of the claims is respectfully requested.

Albazz also does not teach, show, or suggest after execution of said draft, storing data obtained from the resulting contract in said database, said data organized into fields comprising: draft contract status, contract identifier, contract type, effective date, and expiration date; and a field comprising obligation type, status, owner or due date; and said database capable of generating reports based on said data, said reports obtainable through search of said fields; and said database being selectively accessible by a plurality of users; and retrieving from said database a report of outstanding obligations, as recited in claim 12 and those dependent therefrom. Withdrawal of the rejection and allowance of the claims is respectfully requested.

Further, Albazz does not teach, show, or suggest retrieving from said database a report of outstanding financial obligations, as recited in claim 29 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

Still further, Albazz does not teach, show, or suggest retrieving from said database a report of outstanding obligations; analyzing said report to determine which, if any, of said

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obligations should be acted upon; taking action based on said analysis; and updating said database to reflect said action, as recited in claim 43 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

Still further, Albazz does not teach, show, or suggest obtaining from said database an invoice or payment letter wherein said invoice or payment letter is generated automatically using said stored data; and sending the invoice or payment letter, as recited in claim 53 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

Further yet, Albazz does not teach, show, or suggest generating from said database a list of payments due; obtaining from said database an invoice or payment letter wherein said invoice or payment letter is generated automatically using the data stored in said database; sending the invoice or payment letter; and updating the database to reflect that payment was made or to reflect receipt of payment, as recited in claim 62 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

Further still, Albazz does not teach, show, or suggest obtaining from the database an indication as to whether the draft is being reviewed and/or executed; storing, after execution of said draft, data obtained from the resulting contract in said database, said data comprising payment triggering event data; and generating from said database a report of payment triggering events, as recited in claim 69 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

Finally, Albazz does not teach, show, or suggest storing review and/or execution data in a single contract database comprising data obtained from multiple contract documents; obtaining from the database an indication as to whether the draft is being reviewed and/or executed; storing, after execution of said draft, data obtained from the resulting contract in said database, said data comprising payment triggering event data; generating from said database a report of payment triggering events; analyzing the report to determine whether payment should be made; making payment; and updating the database to reflect that payment was made, as recited in claim 76 and those dependent therefrom. Withdrawal of the rejection and allowance of at least these claims is respectfully requested.

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Applicants further traverse the rejection on grounds that the Examiner has not established a *prima facie* case of obviousness. To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Further, the teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, not in the applicants' disclosure. See M.P.E.P. § 2143, citing In re Vaeck, 947 F.2d 488 (Fed. Cir. 1991).

As mentioned above, Albazz discloses numerous databases to negotiate and generate a contract. Each database has its own set of controls and security access. Albazz makes no mention of a single database, and does not motivate or suggest having a single database since the purpose of Albazz's system is to facilitate contract negotiation and contract preparation using predetermined terms and conditions. For at least this reason, withdrawal of the rejection and allowance of the claims is respectfully requested.

Referring to the Examiner comment that it would have been obvious to modify Albazz to include a single contract database because databases are old and well-known in the field, and such a modification would be motivated by the need for greater efficiency in the storage of necessary data for the generation of contracts, the Examiner is kindly reminded that the level of skill in the art cannot be relied upon to provide the suggestion to combine references or make modifications. See M.P.E.P. § 2143.01, citing AI-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308 (Fed. Cir. 1999). Moreover, simply because a claimed device or process uses a known scientific principle does not, of itself, make that device or process obvious. In re Brouwer, 77 F.3d 422, 37 USPQ2d 1663 (CAFC 1996). Moreover, the proposed modification cannot render the prior art unsatisfactory for its intended purpose. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984). Here, Albazz cannot be modified to a single database as suggested by the Examiner since a single database would allow any party the ability to unilaterally change a contract (i.e. the terms and conditions of a contract), which is specifically what the system of Albazz is designed to prevent. See, e.g. Albazz at paragraphs [0092] and [0106]. Accordingly, Albazz does not motivate or suggest the claimed invention. Withdrawal of the rejection and allowance of the claims is respectfully requested.

The secondary references made of record are noted, including Wyman (US 5,204,897) which is a software license tracking system. However, it is believed that the secondary

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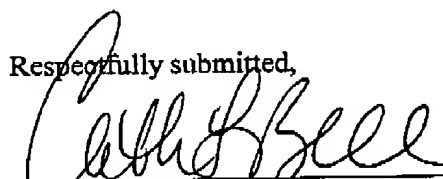
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references are no more pertinent to the Applicant's disclosure than the primary reference cited in the Office Action.

Having addressed all issues set out in the office action, Applicant respectfully submits that the pending claims are now in condition for allowance. A petition for extension of time for filing this response is attached; however, in the event that petition becomes separated from this Response, the Commissioner is hereby authorized to charge counsel's Deposit Account No. 05-1712, for any fees, including extension of time fees or excess claim fees, required to make this response timely and acceptable to the Office.

Feb 7, 2006
Date

Respectfully submitted,



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